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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/492,213 01/27/00 GUNDLING G 6416.US.P1

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ABBOTT LABORATORIES  
DEPT. 377 - AP6D-2  
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EXAMINER

SISSON, B

ART UNIT

PAPER NUMBER

1655

DATE MAILED:

06/20/01

11A  
13

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.

09/492,213

Applicant(s)

GUNDLING ET AL.

Examiner

Bradley L. Sisson

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1655

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 24 May 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1,2,4,5 and 7-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4,5 and 7-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 18) ☒ Interview Summary (PTO-413) Paper No(s) 11.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

## **DETAILED ACTION**

### ***Continued Prosecution Application***

1. The request filed on 30 April 2001 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/492,213 is acceptable and a CPA has been established. An action on the CPA follows.

### ***Specification***

2. The disclosure is objected to because of the following informalities: The specification does not reflect the current status of applications cited therein, e.g., page 7 of the specification where reference has been made to 09/041352.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 2, 4, 5, and 7-16 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Factors to be considered in determining whether a disclosure would require undue experimentation have been summarized in *In re Wands*, 8 USPQ2d 1400 (CAFC 1988). They

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include (1) the quantity of experimentation necessary, (2) the amount of direction or guidance presented, (3) the presence or absence of working examples, (4) the nature of the invention, (5) the state of the prior art, (6) the relative skill of those in the art, (7) the predictability or unpredictability of the art, and (8) the breadth of the claims.

*The Quantity of Experimentation Necessary and The Amount of Direction or Guidance Provided*

The quantity of experimentation required to enable a skilled artisan to practice the full scope of the claimed invention is immense. As amended, the claims more clearly recite that one is to render incapable of use in any amplification reaction, the presence of carry-over or contaminating nucleic acids through the application of an electric current of undefined duration and strength. Claims 2, 5, and 9 have been interpreted as encompassing the separation of any binding pair, be it hormones and their receptors, antibodies and antigens, as well as complementary nucleic acid sequences.

The specification does not provide any examples.

The specification does, however, provide motivation for others to determine how the claimed invention is to be practiced. In support of this position, attention is directed to page 57, lines 4-10, where it is stated:

It is believed that that signal may elute or lyse a nucleic acid. Alternatively, that signal may attenuate, change or otherwise effect biological and/or bio-molecular elements, such as a nucleic acid and the like, in the fluid 95 such that those elements have a reduced ability to be amplified or detected in a PCR reaction.

While it is not a requirement that applicant set forth each and every possible set of conditions that could be envisioned so as to satisfy the requirements for enablement under 35 USC 112, first paragraph, the specification must set forth at least some of those conditions as it is

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now well settled that to not disclose the starting materials and the reaction conditions to be used in practicing the claimed invention unfairly shifts the burden of enablement from that of applicant to the public. The situation at hand is analogous to that in *Genentech v. Novo Nordisk* A/S 42 USPQ2d 1001. As set forth in the decision of the Court:

“ ‘[T]o be enabling, the specification of a patent must teach those skilled in the art how to make and use the full scope of the claimed invention without undue experimentation.’ *In re Wright* 999 F.2d 1557, 1561, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993); *see also Amgen Inc. v. Chugai Pharms. Co.*, 927 F. 2d 1200, 1212, 18 USPQ2d 1016, 1026 (Fed Cir. 1991); *In re Fisher*, 427 F. 2d 833, 166 USPQ 18, 24 (CCPA 1970) (‘[T]he scope of the claims must bear a reasonable correlation to the scope of enablement provided by the specification to persons of ordinary skill in the art.’).

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“Patent protection is granted in return for an enabling disclosure of an invention, not for vague intimations of general ideas that may or may not be workable. *See Brenner v. Manson*, 383 U.S. 519, 536, 148 USPQ 689, 696 (1966) (starting, in context of the utility requirement, that ‘a patent is not a hunting license. It is not a reward for the search, but compensation for its successful conclusion.’) Tossing out the mere germ of an idea does not constitute enabling disclosure. While every aspect of a generic claim certainly need not have been carried out by an inventor, or exemplified in the specification, reasonable detail must be provided in order to enable members of the public to understand and carry out the invention. “It is true . . . that a specification need not disclose what is well known in the art. *See, e.g., Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1385, 231 USPQ 81, 94 (Fed. Cir. 1986). However, that general, oft-repeated statement is merely a rule of supplementation, not a substitute for a basic enabling disclosure. It means that the omission of minor details does not cause a specification to fail to meet the enablement requirement. However, when there is no disclosure of any specific starting material or any of the conditions under which a process can be carried out, undue experimentation is required; there is a failure to meet the enablement requirement that cannot be rectified by asserting that all the disclosure related to the process is within the skill of the art. It is the specification, not the knowledge of one skill in the art, that must supply the novel aspects of an invention in order to constitute adequate enablement. This specification provides only a starting point, a direction for further research.

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*The Presence or Absence of Working Examples*

The specification provides no working examples.

*The Nature of the Invention*

The invention relates to the world of biochemistry and electrical conductance. More specifically, the invention relates to the separation of any type of biological material from any type of ligand in any type of environment.

*The State of the Prior Art*

The aspect of contaminants in various nucleic acid amplification assays is well known in the art as is the effect of contaminants in nucleic acid amplification assays have been approached through the use of chemicals such as uracil-N-glycosylase (UDG; US Patent 5,536,649) as well as the encasement of PCR reactants in a wax matrix (US Patent 5,576,197). The state of the prior art is wholly undeveloped as it relates to the application of electric currents to various samples in an effort to reduce or eliminate any contaminating material, e.g., nucleic acids, as well as any other ligand and its receptor(s).

*The Relative Skill of Those in the Art*

The relative skill of those in the art most closely associated with the claimed invention is high, on par with those that hold a Ph.D. in biochemistry.

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*The predictability or unpredictability of the art*

The predictability of the art is low as it deals with matters of chemistry and cellular physiology- two art areas that have been recognized by the court as being notoriously unpredictable.<sup>1</sup>

*The breadth of the claims*

The claims have been interpreted as encompassing not only the elimination of nucleic acids from virtually any type of sample, but also encompasses the elimination or reduction of any other member of any binding pair in any type of composition.

For the above reasons, and in the absence of convincing evidence to the contrary, the rejection is maintained.

***Conclusion***

4. This is a CPA of applicant's earlier Application No. 09/492,213. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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<sup>1</sup> As noted in *In re Fisher* 166 USPQ 18 (CCPA, 1970):

In cases involving predictable factors, such as that, once imagined, other embodiments can be made without difficulty and their performance characteristics predicted by resort to known scientific laws. In cases involving unpredictable factors, such as most chemical reactions and physiological activity, the scope of enablement obviously varies inversely with the degree of unpredictability of the factors involved.

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bradley L. Sisson whose telephone number is (703) 308-3978. The examiner can normally be reached on 6:30 a.m. to 5 p.m., Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephanie Zitomer can be reached on (703) 308-3985. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3592 for regular communications and (703) 308-0294 for After Final communications.



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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

*B. L. Sisson*

Bradley L. Sisson  
Primary Examiner  
Art Unit 1655

BLS

June 13, 2001